

**REMARKS**

Please reconsider this application in view of the above amendments and the following remarks.

- Claims 1-46 are pending.
- Claims 1-18 and 34 are rejected.
- Claims 19-33 and 35-46 and non-elected species of Claims 35-38 are withdrawn.
- Claims 47-79 are canceled without prejudice.

Applicant have removed the previously added limitation to claims 1 and 34. Applicant has amended claims 1, 15, and 34 to recite that "the base coat mixture is applied directly to an implantable medical device." Support for this amendment can be found at page 7 of the specification, beginning at line 12.

**Common Ownership Statement to invoke 35 USC § 103(c).**

As of the invention date for the current application, number 09/918,365, its inventors and the inventors of U.S. Patent 6,287,285 were subject to an obligation to assign these inventions to Advanced Cardiovascular Systems, Inc. Therefore, 35 USC § 103(c) disqualifies U.S. Patent 6,287,285 for use as obviousness-type prior art against the current application.

**Double Patenting**

Claims 1-18 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 14 of U.S. Patent No. 6,221,425 and claims 1-17 of U.S. Patent No. 6,656,517.

At this point neither the Examiner nor Applicant knows the scope and content of claims that will be found allowable from this application. Once that information is known, if the obviousness-type double patenting rejection is still appropriate, Applicant will promptly file a terminal disclaimer over U.S. Patent No. 6,221,425 and U.S. Patent No. 6,656,517.

Please hold this double patenting rejection in advance until then.

### **Claim Rejections – 35 USC §102**

Claims 1-3, 5, 7, 11-12, 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Cahalan et al. (US Pat. 5,607,475).

Cahalan lacks the step of preparing a base coat mixture for *direct* application to the surface of the medical device, as is required by Applicant's claims, as amended. Cahalan teaches that it adheres a silane compound to the surface of the medical device before applying the acrylate monomer compound, which the Examiner identifies as the base coat mixture. See page 6, line 5 of the current office action.

Since the Cahalan reference does not teach each and every element of Claims 1 and 15, Cahalan does not anticipate these claims.

Since the Examiner has not made out prima facie anticipation of the named dependent claims with this reference because the Examiner has not explained how it teaches each and every element of the parent claim(s), the current rejection of the dependent claims is moot. But Applicant does not acquiesce to the Examiner's various positions in the rejections of sub-groups of the dependent claims and reserves the right to deal with the specifics of those rejections in the future, if that becomes necessary.

Please remove this rejection under 35 USC 102(b).

Claims 1-12, 15-17, 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Michal et al. (U.S. 6,287,285 B1).

Upon indication of otherwise allowable claims, Applicant will provide an affidavit appropriate to address this rejection. Please hold this rejection in abeyance until that time.

**Claim Rejections – 35 USC §103**

Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cahalan et al.

Callahan does not teach direct application of the base coat to an implantable medical device, as is required by the claims as amended. See above.

Please remove this rejection under 35 USC 103(a).

Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Michal et al.

The above statement of common ownership disqualifies this reference as prior art under 35 USC 13.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Cahalan or Michal in view of Hughes et al.

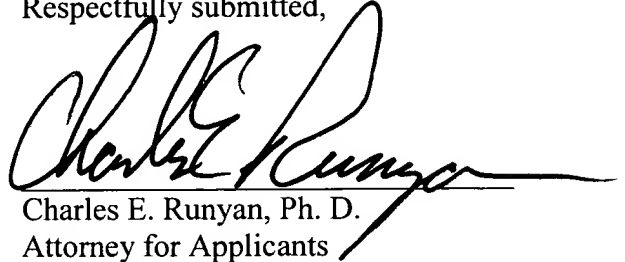
Cahalan is deficient for the reasons discussed above. Hughes does not cure this deficiency. Claim 13 contains each limitation recited in Claim 1. And it is patentable for at least the same reasons as Claim 1. Therefore, prima facie obvious has not been made out.

As for Michal, the above statement of common ownership disqualifies Michal as prior art under 35 USC 103.

Please remove this rejection.

Since all claims are in a condition for allowance, please issue a Notice of Allowability so stating. If I can be of any help, please contact me.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Charles E. Runyan", written over a horizontal line.

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